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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/778,475	02/07/2001	Lori P. Engle	55188USA9C.014	4701

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EXAMINER

FLETCHER III, WILLIAM P

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 01/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/778,475

Applicant(s)

ENGLE ET AL.

Examiner

William P. Fletcher III

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2002 (Paper No. 8).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-33 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED OFFICE ACTION

Note: The election/restriction required by the previous examiner is hereby withdrawn. A new
5 restriction requirement is set-forth below.

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

- 10 I. Claims 1 - 21, drawn to a method of providing a durable image on a substrate, classified in class 427, subclass 258.
- II. Claims 22 - 26, drawn to a method of providing a durable image on a substrate, classified in class 427, subclass 258.
- 15 III. Claims 27 & 28, drawn to an imaged article, classified in class 428, subclass 195.
- IV. Claim 29, drawn to an imaged article, classified in class 428, subclass 195.
- 20 V. Claims 30 - 33, drawn to a kit for providing a durable image on a substrate, classified in class 101, subclass 103.

The inventions are distinct, each from the other because of the following reasons:

25 Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case: invention I requires coating with a mordant dispersion, while invention II requires coating with fluoropolymer; invention II requires a non-porous substrate, while invention I does not; and

invention II requires heating the printed or transferred image above ambient temperature, while invention I does not.

Inventions I and III are related as process of making and product made. The inventions
5 are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product can be made by another and materially different process: either (1) placing a mask
10 defining the selected image atop the mordant coating and spray-applying (i.e. spray-painting) the image through the mask; or (2) applying the mordant layer, the image layer, and/or the hydrophobic layer as preformed sheets to the substrate and laminating them together using an adhesive.

Inventions I and IV are unrelated. Inventions are unrelated if it can be shown that they
15 are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case: invention I requires coating with a mordant dispersion, while invention IV requires a coated fluoropolymer; invention IV requires a non-porous substrate, while invention I does not; and invention IV requires that the printed or transferred image have been heated above ambient temperature, while
20 invention I does not.

Inventions I and V are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice
25 another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus can be used to practice another and materially different process: (1) forming a uniform coating on the coated substrate, rather than a selected image; (2) coating a layer of aqueous mordant dispersion on a substrate; or (3) coating a layer of dispersed hydrophobic material on a substrate.

Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case: invention III requires a substrate coated with a mordant dispersion, while invention II requires a coating a substrate with a fluoropolymer; invention II requires a non-porous substrate, while invention III does not; and invention II requires heating the printed or transferred above ambient temperature, while invention III does not.

Inventions II and IV are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product can be made by another and materially different process: either (1) placing a mask defining the selected image atop the mordant coating and spray-applying (i.e. spray-painting) the image through the mask; or (2) applying the fluoropolymer layer and/or the image layer as preformed sheets to the substrates and laminating them together using an adhesive.

Inventions II and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case: invention II requires an aqueous fluoropolymer dispersion, while invention V does not; and invention V requires a dispersed hydrophobic material, while invention II does not.

Inventions III and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case: invention III requires mordant dispersion coating, while invention IV requires a fluoropolymer coating; invention IV requires a non-porous substrate, while invention III does not; and invention IV requires the printed or transferred image having been heated above ambient temperature, while invention III does not.

Inventions III and V are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case, the product can be made by another and materially different apparatus: one comprising an image transfer medium and pre-formed sheets of mordant and hydrophobic material.

Inventions IV and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case: invention IV requires a fluoropolymer layer, while invention V does not; and invention V requires a dispersed hydrophobic material, while invention IV does not.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (703) 308-7956. The examiner can normally be reached on Monday through Friday, 9 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P. Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

William Phillip Fletcher III
Patent Examiner
United States Patent & Trademark Office
Group Art Unit 1762


FRED J. PARKER
PRIMARY EXAMINER

wpf
January 9, 2003